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In re Application of	:
Orentreich et al.	:Petition to Withdraw Finality
Serial No. : 09/309,689	:Under 37 C.F.R. 1.181(a)
Filed : May 11, 1999	:
Attorney Docket No.: 4555-45US	:

This is in response to applicants petition under 37 CFR 1.181, filed October 27, 2003 requesting withdrawal of the finality of the Office action mailed September 17, 2003 following the filing of an RCE application pursuant to 37 CFR 1.114. The delay in acting on this petition is regretted.

BACKGROUND

In the final Office action (dated 1/9/03) addressing claims 1-22, the Examiner raised the following prior art rejections:

- a. two anticipation rejections of claims 1, 5-6, 8 and 22 over Coleman or Pollack; and
- b. obviousness rejection of claims 1-22 over Coleman or Pollack in view of Grabarek or Wong or Wang.

In response to the Final Office action, applicant filed a Request for Continued Examination (RCE), the fee, and an amendment which included:

- a. cancellation of claims 1-22;
- b. addition of new claims 23-42; and a
- c. 37 C.F.R. 1.132 Declaration by Rozylyn Krajcik.

In making the first Office action (dated 9/17/03) final, the Examiner withdrew the anticipation rejections, while retaining the obviousness rejection as applied to new claims 23-42.

RELEVANT AUTHORITY

An "action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP Section 706.07(b) for making a first action final in a continuing application are met". See MPEP 706.07(h)(VIII).

I. In accordance with MPEP 706.07(b) "Final Rejection, When Proper on First Action", a first office action final rejection is proper where:

- (A) the new application is a continuation application of ... an earlier application, and*
- (B) all claims of the new application*
 - (1) are drawn to the same invention claimed in the earlier application, and*
 - (2) would have been properly finally rejected on the grounds of the art of record in the next Office action if they had been entered in the earlier application.*

However, it would not be proper to make final a first Office action in a continuing or subsequent application where the application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because

- (A) new issues were raised that required further consideration and/or search, or*
- (B) the issue of new matter was raised.*

II. In accordance with MPEP 706.07 "Final Rejection", before final rejection, a clear issue should be developed between the examiner and applicant. In this regard:

The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application ... can no longer find a refuge in the rules to ward off a final rejection.

The Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

DISCUSSION

Applicant argues that the final rejection of the RCE application was improper since it failed to comport with the guidelines in MPEP 706.07 insofar that applicant filed an RCE to secure admittance of amended claims and a Rule 132 Declaration and the making of a premature final rejection:

- a. denies applicant the opportunity to address the Examiner's objections without being under final;
- b. penalizes applicant for undertaking to streamline the after-final process;
- c. places application in position for appeal without a fully developed record on the claims to which appeal is directed; and
- d. places applicant in position of responding to an unclear rejection set forth under 35 USC 103(a).

Applicant's last argument has merit. In particular, it is unclear from the rejection whether Grabarek, Wong and Wang can be substituted one for another in the rejection or whether they are used together in the rejection. The rejection statement lists these three references in the alternative while the reasoning in the rejection appears to require and build upon different teachings from each reference to develop the obviousness rejection. From the body of rejection, it appears the Barbarek is relied upon for the teaching of limitations in claims 25, 26 and 38; Wong is relied upon for the teaching of limitations in claim 36. Wang appears to teach limitations in claims 27 and 33. For these reasons, the finality was improper. Clarification of the obviousness rejection is required.

DECISION

Applicant's petition to withdraw finality of the first Office action mailed September 17, 2003 is **GRANTED** for the reasons set forth above.

Finality of the Office action mailed September 17, 2003 is withdrawn. This application will be forwarded to the examiner for preparation of an Office action in conformance with this decision.

Applicant may consider a petition for reimbursement of the \$165.00 fee for the Notice of Appeal filed on 12/22/03.

Should there be any questions regarding this decision, please contact Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0512 or by facsimile transmission at (571) 305-7230.



Bruce Kisliuk
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